

Consideration of References Cited in the Information Disclosure Statement


During the January 21, 1999 interview the Examiner explained to the undersigned that certain of the documents (*i.e.*, the International Search Reports ["ISR" hereinafter]) were struck from the IDS because they are not the type of documents that can be cited on the face of a patent. The undersigned explained that Applicants believe that the present Examiner would find these documents helpful and submit them as a courtesy. This is because the ISR contain the impressions of the PCT Examiner concerning the relevance of the documents cited therein for the corresponding foreign application.

Rejections under 35 U.S.C. § 112, first paragraph

Claims 66, 67, 70, and 72-79 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time the application was filed.

In particular, it is the Examiner's position that there is no written descriptive support in the specification for the recitation in the rejected claims regarding polypeptide fragments of 30 or 50 amino acids. Applicants respectfully disagree and traverse this rejection.

Applicants direct the Examiner's attention to the first two lines of page 13 which states that polypeptide fragments of the present invention include fragments of 30 and 50 amino acids. Thus, this ground for rejection is in error and should be withdrawn.




Rejection under 35 U.S.C. § 112, second paragraph

Claims 60-67 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Particularly, the Examiner contends that the recitation of "the same polypeptide" and "the cDNA" in subparagraph (a) of claim 60 have insufficient antecedent basis. Applicants respectfully disagree and traverse this rejection.

However, in an effort to expedite prosecution, Applicants have amended the claims in accordance with the suggestions made by the Examiner during the January 21, 1999 interview to recite "mature Tumor Necrosis Factor Receptor polypeptide" in lieu of "the same polypeptide". During this interview the Examiner agreed that the recitation of "the cDNA in ATCC Deposit No. 75899" was acceptable language since it refers to a particular deposit which contains a particular cDNA insert. Thus, the this ground of rejection should be withdrawn as it has been rendered moot.

Rejections under 35 U.S.C. § 102(f)

Claims 60-67 have been rejected under 35 U.S.C. § 102(f) because Applicants allegedly did not invent the claimed subject matter. It is the Examiner's position that the pQE9 vector, which is made and sold by Qiagen, Inc., synthesizes antibiotic resistance protein when expressed in the cell and inherently comprises the specified fragment sizes recited in the claims. Thus, the Examiner concluded that the vector meets the limitations of claims 60-67. Applicants respectfully disagree with the Examiner's reasoning and traverse this rejection.



The rejected claims are directed to human tumor necrosis factor receptor cDNA in ATCC Deposit No. 75899 and do not encompass the vector backbone alone. However, in an effort to further prosecution and clarify the invention, Applicants have amended the claims in accordance with the suggestions made by the Examiner during the January 21, 1999 interview. As amended, the claim now recites "a polynucleotide encoding mature Tumor Necrosis Factor Receptor polypeptide as encoded by the cDNA in ATCC Deposit No. 75899." Thus, the rejection under 35 U.S.C. § 102(f) should be withdrawn.

Conclusion

Applicants appreciate the Examiner's acknowledgment that claims 31, 36-59 and 68, 69 and 80-85 were allowed.

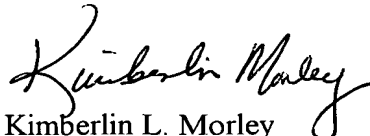
All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If, for any reason, a personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned directly at (202) 371-2627.

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Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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